



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/330,272	06/11/1999	RICHARD ZAFFINO	113304	9223

23838 7590 04/05/2004

KENYON & KENYON
1500 K STREET, N.W., SUITE 700
WASHINGTON, DC 20005

EXAMINER

VANDERPUYE, KENNETH N

ART UNIT	PAPER NUMBER
----------	--------------

2661

12

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/330,272

Applicant(s)

ZAFFINO, RICHARD

Examiner

Kenneth N Vanderpuye

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-21, 23 and 24 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7 and 22 is/are rejected.
- 7) ☒ Claim(s) 5 and 8-11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

Claim 11 is objected to because of the following informalities: Claim 11 should be dependent on either claim 5 or 8. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-7, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Hartmaier(6,304,753).

With regards to claim 1, the admitted prior art teaches a method comprising the steps:

Receiving a registration request for the subscriber at a service node(Fig. 1, MSC). What the admitted prior art fails to teach is determining at the service node an address communicable with an alternative network and associated with the wireless service for a plurality of subscriber devices;(Hartmaier teaches use of a TIP address. In col. 4 lines 57-65,

unlike the PIP address the TIP address is for use by any mobile and is selected from a pool based on need. There is no one-to-one correspondence between the PIP and TIP as suggested by the applicant . Hartmaier makes a distinction between permanent IP addresses which uniquely identifies a mobile and a TIP which is assigned temporarily while the mobile is obtaining service from the MSC), transferring information in support of the wireless service between the subscriber and an information source or recipient using the determined address.(Hartmaier uses TIP for transferring information between the mobile and a database at the HLR). It would have been obvious to one of ordinary skill in the art to combine Hartmaier with the admitted prior art for the purpose of enabling dynamic IP addressing for transmission over the data network. The motivation being efficient use of IP addresses.

Claim 2-3 is rejected because in Hartmaier, the MSC is capable of using the SS7(connection oriented, circuit switched) or the data network(connectionless network, packet switched , IP). It would have been obvious to combine Hartmaier with the admitted prior art for the same reasons above.

Claim 4 is rejected because Hartmaier teaches assigning TIP addresses for use over the internet.). It would have been obvious to combine Hartmaier with the admitted prior art for the same reasons above.

Claims 6-7 are rejected because the use of a wireless protocol is inherently taught because a wireless is necessary to support wireless internet access. Such protocols can include GSM, ANSI-41 which may be selected as a matter of design choice.). It would have been obvious to combine Hartmaier with the admitted prior art for the same reasons above.

Claim 22 is rejected because teaches a serving mobile switching center(Fig. 1, MSC).). It would have been obvious to combine Hartmaier with the admitted prior art for the same reasons above.

Allowable Subject Matter

Claims 12-21, 23-24 allowed.

Claims 5, 8-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed 1/22/04 have been fully considered but they are not persuasive. Applicant argues that in Hartmaier there is a one-

to-one correspondence between TIP and PIP. The examiner respectfully disagrees. The use of temporary addresses is for efficient use of the address. The use of TIP addresses is similar to the function performed by a DHCP server. Temporary IP addresses are so named because a subscriber is allowed to access this pool when needed. This way very few addresses are needed since it is unlikely that all subscriber will access the internet at the same time. No where in Hartmaier is it stated that there is a one-to-one correspondence.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth N Vanderpuye whose telephone number is 703-308-7828. The examiner can normally be reached on M-F(7:30-5:00) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Olms can be reached on 703-305-4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KNV
4-4-04



KENNETH VANDERPUYE
PRIMARY EXAMINER